

### REMARKS

The present application relates to hybrid maize plant and seed X1139Y. Claims 1-41 are currently pending in the present application. Applicant respectfully requests consideration of the following remarks.

#### Detailed Action

##### *A. Specification*

The Examiner maintains the objection to the specification for containing blank lines on page 7 in the bottom paragraph stating that the blank lines appear to be in place of missing accession numbers for the inbred parents of X1139Y, not X1139Y itself. Applicant respectfully submits that the actual ATCC deposit will be delayed until the receipt of notice that the application is otherwise in condition for allowance. While Applicant does not agree that this rejection is appropriate under 37 C.F.R. §§ 1.801-1.809, Applicant will refrain from deposit of Hybrid X1139Y and inbred parents GE565937 and GE502199 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository. The claims will also be amended to recite the ATCC deposit number. In addition, Applicant submits that at least 2,500 seeds of Variety X1139Y and inbred parents GE565937 and GE502199 will be deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed (MPEP § 2411.02). Such action is respectfully requested.

##### *B. Claim Objections*

Applicant acknowledges the rejection of claims 1-32 under the judicially created doctrine of obviousness-type double patenting is withdrawn in light of the claim amendments. Applicant further acknowledges the rejection of claims 1-32 under 35 U.S.C. § 102(e)/103(a) are withdrawn in light of the claim amendments.

Applicant further acknowledges claims 12, 16, 25, and 29 remain objected for the reasons of record stated in the Office Action mailed on June 19, 2002, under item 1. Applicant thanks the Examiner for pointing out this inadvertent error. The changes were made to the "marked

version" but not transcribed to the "clean version". Nonetheless, claims 12, 16, 25 and 29 have now been canceled making this rejection moot.

*C. Claims and Specification*

Applicant acknowledges the addition of new claims 42 through 63, as suggested by the claims faxed by Supervisory Patent Examiner Amy Nelson on August 2, 2002 and again on November 15, 2002 by Examiner David Fox. The new claims do not add new matter as there is literal support for the claims in the originally filed specification (pages 41-53, specification). Finally, Applicant submits that the Deposits section has been amended in order to properly include both the hybrid maize plant and the inbred parents within the deposit paragraph. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The specification has now been amended to correct these minor changes.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-32 remain and new claims 33-41 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the June 19, 2002 Office Action. Applicant's arguments were fully considered but were not found fully persuasive. The Examiner states Applicant's assurance that seed of corn plant X1139Y will be deposited with the ATCC, and the deposit number inserted into the claims, upon receipt of a notice of allowable claims satisfies the issue concerning the recitation "X1139Y". The Examiner further states the rejection applies to new claim 33 as it refers to two other corn plants, GE565937 and GE502199. No assurances have been provided concerning their ATCC deposit. Further, the Examiner states the recitation of "(commercial designation)" still appears in claims 1, 5, and 7.

Applicant respectfully traverses this rejection. Applicant respectfully submits that the actual ATCC deposit will be delayed until the receipt of notice that the application is otherwise in condition for allowance. While Applicant does not agree that this rejection is appropriate under 37 C.F.R. §§ 1.801-1.809, Applicant will refrain from deposit of Hybrid X1139Y and inbred parents GE565937 and GE502199 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to

contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository. The claims will also be amended to recite the ATCC deposit number. In addition, Applicant submits that at least 2,500 seeds of Variety X1139Y will be deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, second paragraph, should be removed (MPEP § 2411.02). Such action is respectfully requested. In addition, Applicant has now amended claims 1, 5 and 7 to cancel the language "commercial designation". Applicants thank the Examiner for pointing out this unintentional mistake.

Claims 11, 15, 19, 24, 28 and 32 remain indefinite in their recitation of such adjectives as "excellent", "good" or "very good" yield potential as these terms are unclear how one would differentiate "excellent" from "good" or "very good" yield potential.

Applicant has canceled claims 11, 15, 19, 24, 28 and 32, thus alleviating this rejection.

Claim 6 stands rejected as there is improper antecedent basis for the phrase "protoplasts" in line 1.

Applicant has now amended claim 5 to read -- A tissue culture of regenerable cells or protoplasts --, thereby alleviating the rejection to claim 6.

The Examiner rejects claims 8 and 21 for the recitation "has been manipulated to be male sterile" which renders the claims indefinite. It is not clear if the claim is directed towards detasseled plants, or plants that have been transformed with a gene conferring male sterility.

Applicant respectfully traverses this rejection. Applicant submits support can be found on page 13 of the specification, wherein it states "[i]t should be understood that the inbred can, through routine manipulation of cytoplasmic or other factors, be produced in male-sterile form. Such embodiments are also contemplated within the scope of the present claims." Further, the specification states hybrid maize seed is typically produced by a male sterility system incorporating manual or mechanical detasseling" (page 2, specification). In addition, the "detasseling process can be avoided by using cytoplasmic male-sterile inbreds" (page 2, specification). As taught in the specification there are several methods of conferring male sterility. Therefore, Applicant asserts that one skilled in the art would not find the terminology indefinite. In addition, claim 21 has now been canceled, alleviating this rejection.

The Examiner rejects claim 33 for the recitation "developing from the cross a hybrid maize plant" in line 4 renders the claim indefinite. The claim does not clearly indicate that the hybrid maize plant in the recitation is the same as X1139Y, mentioned in line 1.

Applicant has now canceled claim 33, thereby alleviating this rejection.

Claim 34 stands rejected for the recitation "essentially" in line 3 which renders the claim indefinite. The Examiner continues by stating that the recitation makes the metes and bounds of the claim unclear.

Applicant has canceled claim 34, thus alleviating this rejection.

The Examiner rejects claim 39 for the recitation "on average, at least 50%" in line 2 that renders the claim indefinite. It is not clear what is being referred to by this recitation. The metes and bounds of the claims are not clear.

Applicant has now canceled claim 39, alleviating this rejection.

Claim 40 stands rejected for the recitation "A X1139Y maize plant selected from the population of X1139Y progeny maize plants" which renders the claim indefinite. The claim is drawn to plant X1139Y, yet can comprise less than 100% of the alleles of X1139Y.

Applicant has canceled claim 40, thereby alleviating this rejection.

The Examiner rejects claim 41 for the recitation "further comprising applying double haploid methods" renders the claim indefinite. The recitation broadens the scope of parent claim 38, which only involves crosses and does not encompass any double haploid method. It is also not clear what double haploid method is being referred to.

Applicant has now canceled claim 41 and additionally claim 38, thus alleviating this rejection.

Claims 11, 15, 19, 24, 28, 32, 39, and 40 stand rejected for the recitations "has derived at least 50% of its ancestral alleles" in claims 11, 15, 19, 24, 28, and 32, and "deriving at least 50% of its ancestral alleles" in claims 39 and 40 which render the claims indefinite. It is not clear what is meant by "derived" and "deriving."

Applicant has canceled claims 11, 15, 19, 24, 28, 32, 39, and 40, thereby alleviating this rejection.

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 11-19 and 24-32 remain rejected and claims 9, 10, 22, 23, and 34-41 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reason of record stated in the June 19, 2002 Office Action. Applicant's arguments were fully considered but were not found fully persuasive.

Applicant acknowledges the written description rejection to claims 8 and 21 as withdrawn. Applicant has now canceled claims 9-19 and 21-41, thus alleviating this rejection. Applicant has added new claims 42 - 63 as suggested by claims faxed by Supervisory Patent Examiner Amy Nelson on August 2, 2002 and again on November 15, 2002 by Examiner David Fox. Applicant believes the new claims come within the purview of the written description requirement and do not add new matter.

Claim 33 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record stated in the June 19, 2002 Office Action for claims 1-32. Applicant's arguments have been fully considered and found persuasive for claims 1-32. Applicant's arguments were not persuasive for new claim 33 which is drawn towards a method of making a hybrid plant designated X1139Y comprising crossing inbred maize plants GE565937 and GE502199 and that these two lines do not appear to be readily available to the public, as they are proprietary lines, and their deposit is required.

Applicant has canceled claim 33, thus alleviating this rejection. In addition, Applicant would like to reiterate that Applicant will refrain from deposit of Hybrid X1139Y and inbred parents GE565937 and GE502199 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository. The claims will also be amended to recite the ATCC deposit number. In addition, Applicant submits that at least 2,500 seeds of Variety X1139Y and inbred parents GE565937 and GE502199 will be deposited with the ATCC. In view of this assurance, the

rejection under 35 U.S.C. § 112, first paragraph, should be removed (MPEP § 2411.02). Such action is respectfully requested.

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 9-19 and 21-41 under 35 U.S.C. § 112, first paragraph.

**Conclusion**

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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